

REMARKS

Reconsideration of the instant application is respectfully requested. The present amendment is responsive to the Office Action of May 10, 2006, in which claims 1-16 are presently pending. Of those, claims 1-5, 8-13 and 16 have now been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,753,538 to Musil, et al., in view of U.S. Patent 6,646,259 to Chang, et al. In addition, claims 6, 7, 14 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Musil and Chang, and further in view of U.S. Patent 6,303,399 to Engelmann, et al. A courtesy copy of the claims in their present form is provided herein. For the following reasons, however, it is respectfully submitted that the application is in condition for allowance.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that (1) all elements of the claimed invention are disclosed in the prior art; (2) that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references; and (3) that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

With regard to the second element, there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The

level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

A statement that modifications of the prior art to meet the claimed invention would have been “ ‘well within the ordinary skill of the art at the time the claimed invention was made’ ” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

In the present Office Action, the Examiner takes the position that Musil teaches preparing a specimen for application of microanalysis thereto, the method comprising forming an initial layer only over a localized area of interest, without blanket coverage of the initial conductive layer, the initial conductive layer formed through a low energy electron beam deposition process.

However, a review of the teachings of Musil reveals that electron beam processing therein is particularly directed toward repairing defects in lithography masks, not in the context of TEM sample preparation. (See, for example, “Abstract”; Fig. 3; Fig. 5; Col. 1, lines 9 - Col. 2, line 64; Col. 3, line 61 - Col. 4, line 6.) Although Musil provides a general disclaimer that electron beam processing “is also useful for processing metals and other materials on any type of workpiece,” there is no specific teaching therein with regard to TEM sample preparation. More specifically, there is no teaching or suggestion in Musil that a TEM sample could or should be prepared by implementing localized deposition of a conductive layer in the first place.

As stated previously by the Applicant, Chang fails to provide a teaching or a motivation to form the initial conductive layer in a localized manner. Further, Chang fails provide a teaching or a motivation to form a conductive layer through low energy, e-beam deposition. The teachings of Musil do not provide this missing motivation, and therefore one skilled in the art has no motivation to apply localized e-beam deposition as taught in Musil to the TEM sample preparation method of Chang, because Chang fails to teach or suggest the need for deposition of localized conductive metal in the first place.

Accordingly, the Applicant respectfully requests that since the present claims are not obvious in view of Chang or any of the other references of record, the final §103 rejections be withdrawn.

For the above stated reasons, it is respectfully submitted that the present application is now in condition for allowance. No new matter has been entered and no additional fees are believed to be required. However, if any fees are due with respect to this Amendment, please charge them to Deposit Account No. 09-0458 maintained by Applicant's attorneys.

Respectfully submitted,
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